

REMARKS

With the entry of this Amendment, claims 12, 15-18 and 20 will be pending in this patent application.

ENTRY OF AMENDMENTS

In this paper, Applicant is proposing the cancellation of claim 21 and is proposing amendments to claims 12 and 16. The amendment to claim 12 is a response to the Examiner's comment in the second paragraph on page 9 of the outstanding Office Action. In particular, the proposed amendment to claim 12 clarifies the relationship of the contours of the first and second steps of the multi-step hole and obviates any ambiguity that the Examiner may have discerned in the claim. The proposed amendment to claim 16 corrects the dependency of the claim. Applicant submits that the amendments to the claims proposed herein do not introduce new issues to be considered by the Examiner and, in fact, reduce and clarify the issues presented in this application. Furthermore, claims 12, 15-18 and 20 are allowable for reasons presented below. Accordingly, Applicant respectfully requests that the amendments to the claims presented herein be entered. Alternatively, Applicant respectfully requests that the amendments to the claims presented herein be entered for purposes of appeal if an appeal to the Board of Patent Appeals and Interferences should become necessary.

PRIOR ART REJECTION

Claims 12, 15-18, 20 and 21 stand rejected under 35 USC § 103(a) as being unpatentable over JP 59-25684 (JP '684) in view of SU 408333 (SU '333) and optionally JP 55-110608 A (JP '608) and/or US 5980668 (Slingluff). Applicant traverses this rejection.

As an aid to the Examiner's assessment of the disclosure in JP '684, Applicant is attaching to this paper a partial English translation of JP '684 ("the translation").

The Examiner specifically cites Fig. 2(f) of JP '684 as showing a wear indicating portion formed as a "hole" in the tread with a first step at the tread surface and a second step at a lower depth of the tread. However, JP '684 cannot be fairly characterized as a wear indicator that reveals tread wear by a *change in the shape of the hole*. Rather, JP '684 explicitly requires symbols or indicia for providing an indication of "abrasion degree," or tread wear. See, for

example, pages 1 and 3 of the translation: "... that a symbol indicating a grade of an abrasion degree is provided in the abrasion degree display portion." This observation is reinforced by the first paragraph beginning on page 4 of the translation: "... and symbols 2a each indicating a grade of an abrasion degree are provided in this abrasion degree display portion 2." Symbols 2a are employed in abrasion degree display portions 2 in all of the embodiments illustrated in Fig. 2 and Fig. 3 of JP '684. As shown, for example, in Fig. 2(d) of JP '684, the symbols or indicia are in the form of numbers 1, 2, 3, disposed in a sidewall of a recess in the tread T, with each higher number indicating a greater degree of tread wear. That is, an observation of the symbols or indicia enables a determination of the extent of tread wear. Thus, the indicators disclosed in JP '684 cannot be fairly characterized as performing an indication of tread wear by a change in shape of a hole, as the Examiner suggests. Rather, it is the symbols or indicia in a sidewall of the recessed formations that provide an indication of tread wear. The symbols or indicia are essential to the invention disclosed in JP '684. Applicant submits that this must be acknowledged in a reasonable consideration of the disclosure in JP '684.

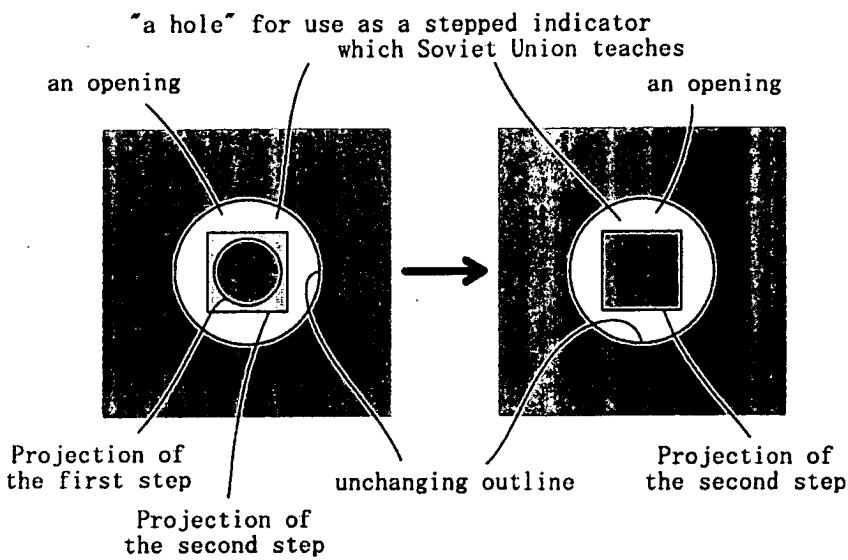
As observed above, in JP '684, the embodiments shown in Fig. 3(a) and Fig. 3(b) are described together with, and incorporate the attributes of, the embodiments shown in Fig. 2(a) to Fig. 2(f), even though a contour of the concave recessed portions of the embodiments of Fig. 3(a) and Fig. 3(b) changes slightly due to tire wear, and even though a part of a contour of concave recessed portions of Fig. 2(a) to Fig. 2(f) changes due to tire wear.

The Examiner characterizes Fig. 3 of SU '833 as illustrating a "SECOND EMBODIMENT" in which the "indicator is within one of the lugs." The Examiner refers to the text in the Abstract of SU '833, "... the wear indicator ... can have the form of an opening in one of these projections." The Examiner then concludes that "Soviet Union teaches (1) a "projection" for use as an indicator having a stepped or (2) a "hole" for use as an indicator having a stepped shape." The Examiner also cites Fig. 6 of SU '833 as showing a wear indicator with a circular upper step and straight-sided intermediate and lower steps. Applicant observes that the wear indicator shown in Fig. 6 (as well as Figs. 4 and 5) of SU '833 is clearly a solid projection.

As shown in Fig. 3 of SU '833, a wear indicator, clearly illustrated as a projection having stepped sides, is disposed in a hole in the tread. At an interview at the office of the Examiner on

June 25, 2008, the Examiner argued that Fig. 3 of SU '833 did not show a projection in a hole in the tread but instead showed a stepped void in the tread in which the smallest step of the void reaches to the tread surface. Applicant submits that the disclosure in SU '833 provides no basis for the Examiner's interpretation of the illustration in Fig. 3 of SU '833. The shading lines in the side walls of the steps of the indicator as shown in Fig. 3 clearly denote a solid element. If a void in the tread was intended, it could have been easily illustrated. A projection *is* illustrated; a void *is not* illustrated. Applicant therefore submits that the indicator shown in Fig. 3 of SU '833 can only be construed as a projection in an opening in the tread. There is simply no reasonable basis for construing the indicator shown in Fig. 3 of SU '833 as a void with stepped sidewalls.

As shown in the illustrations below, the wear indicator shown in Fig. 6 of SU '833 will reveal tread wear by a change in the shape of the *projection* in a hole in the tread; the shape of the edge of the hole will not change.



In view of the foregoing discussion of the attributes of the wear indicators disclosed in JP '684 and SU '833, Applicant submits that the tread wear indicators disclosed in JP '684 and SU '833 are fundamentally different in structure and function and that the Examiner's characterization of these documents to the contrary is incorrect. Applicant further submits that there is no disclosure in either of JP '684 and SU '833 that provides a sound basis for combining their teachings as the Examiner proposes. That is, the Examiner's conclusion that, "one of

ordinary skill in the art would have found it obvious to use *different shapes* for the steps of the wear indicating hole of Japan 684 - only the expected results of facilitation of indication of tire tread wear being obtained" requires a distortion of the disclosure in JP '684 and an improper application of the disclosure found only in this application to the disclosures in JP '684 and SU '833.

The Examiner cites JP '608 as disclosing a stepped hole 17 for indicating wear and cites Slingluff as disclosing a wear indicator with pattern parts such as holes that indicate tread wear by the disappearance of the holes. Neither of these documents offers teachings that can remedy fundamental deficiencies in the disclosures in JP '684 and SU '833, as discussed above.

In view of the foregoing observations, Applicant submits that no reasonable combination of the disclosures in JP '684, SU '833, JP '608 and Slingluff can properly serve as a basis for rejecting claims 12, 15-18, 20 and 21 under 35 USC § 103(a).

CONCLUSION

In view of the observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection stated in the outstanding Office Action and recognize all of the pending claims as allowable.

If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number provided below, so that these matters can be addressed and resolved expeditiously.

Application No. 10/532,424
Amendment dated September 10, 2008
After Final Office Action of June 10, 2008

Docket No.: 0080-0234PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: September 10, 2008

Respectfully submitted,

By *Andrew R. Meikle* #32868
for Andrew D. Meikle
Registration No.: 32,868
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: partial English translation of JP 59-25684